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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,010	02/09/2001	Gordon James Smith	ROC920000267US1	6426

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EXAMINER	
NGUYEN, TAN D	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,010	SMITH, GORDON JAMES	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 21-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 21-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 1/13/2005, PROSECUTION IS HEREBY REOPENED. The new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Applicant's argument with respect to the 103 rejections of claims 1-8, 21-31 over INTERLOTTO Article in view of JAFFE are persuasive and the rejections are withdrawn.

Applicant's argument with respect to the 101 rejections of claims 1-9 are persuasive and the rejections are withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 6-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 02/37345.

As for independent claim 1, WO 02/37345 discloses a method for automating contributions in a gaming system comprising:

(a) prompting the user with a gaming **option** in an automated gaming system {see Fig. 1 or 3, page 9-10 "option 18"};

(b) enabling the user to pledge a contribution to an organization ("charity bet option 18"), said pledge being contingent on a result of the gaming option, said pledge being input to the automated gaming system {see Fig. 1 or 3, page 10};

(c) permitting the user to make a wager and partake in the gaming option in said automated gaming system; said automated gaming system determining said result using said wager and gaming option {see Fig. 1 or Fig. 3, page 10};

(e) automatically making a contribution to the organization based on the pledge of step (b) and said result {see Fig. 1 or 3, page 7, lines 24-27 "Internet ..web pages", 10}. Alternatively, the use of other similar term beside "charity bet" to indicate pre-selected portion given to charity upon winning such as "pledge or making a pledge or making a promise" would have been obvious as mere using other similar term to achieve the same results, absent evidence of unexpected results.

As for dep. claim 2 (part of 1), which deals with a well known fundraising parameters, i.e. selection type of organization, this is non-essential to the scope of the claimed invention and is taught in page 10.

As for dep. claim 3 (part of 1), which deals with a well known fundraising parameters, i.e. selection size of contribution, this is non-essential to the scope of the claimed invention and is taught in page 9 or Fig. 1 or 3.

As for dep. claim 6 (part of 1), the term "payout" reads over "winning" or a result of winning, this is taught on page 10, or Fig. 3, (72), (74).

As for dep. claim 7 (part of 1), which deals with payout limitation, this is taught on page 10 or Fig. 3, (72), (74).

As for dep. claim 8 (part of 1), which deals with well known gaming parameters and fundraising parameters, i.e. tallying up results after series of games, this is taught on page 10.

As for dep. claim 9 (part of 1), which deals with well known gaming and fundraising parameters, i.e. providing information with respect to gaming option and contribution to the IRS for tax reporting purpose, these are inherently included in the

teachings of WO 02/37345 on pages 7 & 15 or would have been obvious to do so for tax reporting record.

5. **Dep. claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/37345 as applied to claims 1-5, 7-9 above, and further in view of KILEN (Article of 4/2000 "Lure of Sweepstakes?").**

As for dep. claims 4-5 (part of 1), which deals with other well know gaming parameters, i.e. odds of winning based on user's spending/purchasing/buying/donating, KILEN is cited to show well known illegal practice/conception of odds of winning or increase chances of winning by making purchase or donations to entity in playing games, or in other word, odds of winning related to consumer's spending/giving/donation/contribution {see abstract}. However, because legality is not an issue of patent application since this issue can change with time and place, it would have been obvious to modify the teaching of WO 02/37345 by including this practice as taught by KILEN to entice more donating or pledging of donation contributions, thus increasing the odds or chances for the consumer to win the games while increasing donations to charity entity.

Note that the odd for winning in (a) is shown by WO 02/37345 on Fig. 3 (72) or (74).

Note also that the term "donation" reads over "pledge to donate" or it would have been obvious to make a pledge to donate in view of the teaching of "donation" as taught by WO 02/37345 in view of KILEN.

6. **Dep. claims 4-5 are rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over WO 02/37345 as applied to claims 1-5, 7-9 above, and further in view of WOLLER (Article of 8/1999 "Senate Oks .. Elderly").**

As for dep. claims 4-5 (part of 1), which deals with other well know gaming parameters, i.e. odds of winning based on user's spending/purchasing/buying, WOLLER is cited to show well known illegal practice/conception of odds of winning or increase chances of winning by making purchase or buying materials from entity in playing games, or in other word, odds of winning related to consumer's spending/buying/purchasing {see abstract}. However, because legality is not an issue of patent application since this issue can change with time and place, it would have been obvious to modify the teaching of WO 02/37345 by including this practice as taught by WOLLER to entice more purchasing, thus increasing the odds or chances for the consumer to win the games while increasing donations to charity entity.
Note that the odd for winning in (a) is shown by WO 02/37345 on Fig. 3 (72) or (74).
Note also that the term "donation" reads over "pledge to donate" or it would have been obvious to make a pledge to donate in view of the teaching of "donation" as taught by WO 02/37345 in view of KILEN.

7. **Dep. claim 6 is rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over WO 02/37345 as applied to claims 1-5, 7-9 above, and further in view of TORANGO (US 2003/00600279).**

As for dep. claim 6, the teachings of WO 02/37345 is cited above. TORANGO is cited to show well known teaching in the gaming art which is as the participant

contributes more to the game prize, the odds of winning the prize becomes smaller, giving the participant a better chance at winning the prize {see Fig. 7, [0102]}. In other word, as % of contribution goes up, the odds or winning becomes smaller or the chance of winning goes up or % winning is direct proportional to the % of contribution of game prize (i.e. investing 50$ by buying 2 lottery tickets at $25.00/ticket has more chances of winning the prize than investing only $25 by buying 1 lottery ticket at $25.00/ticket). The total contribution to the game or the total cost to the player can be in the form of the buying more tickets or portion or giving more to charity or donation in this case. Therefore, it would have been obvious to modify the gaming step of WO 02/37345 by tying the winning percentage to the level of contribution to charities (or overriding the 1st incentive with a 2nd incentive selected from the group consisting of a 2nd odds of winning and a 2nd payout, wherein the 2nd incentive is greater than the 1st incentive) as taught by TORANGO to encourage increase the level of contribution to charities and chances for winning.

8. Claim 9 is rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over WO 02/37345 as applied to claims 1-8 above, and further in view of ZIARNO (US 6,253,998).

As for dep. claims 9 (part of 1), the teaching of WO 02/37345 is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or attender or other agency for tax purposes since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can

be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would have been obvious to modify the process of WO 02/37345 by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since everything in INTERLOTTO is done on the Internet, this step can be carried out automatically along with other functions.

9. Claims 21-25, 27, 28-30 are rejected under 35 U.S.C. 103(a) as being obvious over WO 02/37345.

As for Independent claim 21 which deals with the apparatus to carry out the method of claim 1, it's rejected over the system of WO 02/37345. Alternatively, the set up of an equivalent apparatus to carry out an equivalent method of claim 1 would have been obvious to a skilled artisan.

As for dep. claim 22 (part of 21), the interactive feature is inherently included in the teaching of WO 02/37345 which discloses the carrying out of the invention using a web site on the Internet {see page 7, lines 24-27} and the user has to input/enter selection variables. Alternatively, it would have been obvious to have an interactive step to allow more effective and dynamic interaction between the user and the gaming apparatus.

As for dep. claim 23 (part of 21), this limitation of "determining the result based on a random process" is inherently included in the lottery game of WO 02/37345 since lottery is normally a game of chance and depends on a random process.

As for dep. claim 24 (part of 21), this is fairly taught in the teachings of WO 02/37345 wherein a favorable result probability to the user is formed if he makes a promise/pledge of contribution of a portion of winning prize to charities.

As for dep. claim 25 (part of 21), which has similar limitation as in dep. claim 3 above, it's rejected for the same reason set forth in dep. claim 3 above.

As for dep. claim 27 (part of 21), which talks about the user device comprises an interactive visual display terminal, the interactive feature is inherently included in the teaching of WO 02/37345 Article which discloses a web site and the user has the ability to input/enter selection variables.

As for Independent claim 28 which discloses a program product for use in an automatic gaming apparatus and the processor to carry out the same steps as in Independent claim 21, it's rejected over the program product to carry out the Internet-based lottery of WO 02/37345.

As for dep. claims 29-30 (part of 28), which have the same limitation as in dep. claims 22-24, they are rejected for the same reasons set forth in claims 22-24 above.

10. Claims 26, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/37345 as applied to claims 21-25, 27 and 28-30 respectively above, and further in view of ZIARNO (US 6,253,998).

As for dep. claims 26, 31(part of 21 and 28 respectively), the teaching of WO 02/37345 Article is cited above. In another fundraising process, ZIARNO is cited to teach the use of a receipt generator (820) to mail or fax or send/forward multiple copies of the contribution to the contributor or participant or other agency for tax purposes

since the contribution to charities is normally tax deductible (Fig. 15a, col. 9, lines 5-47). ZIARNO mentions that format can be accepted by the IRS which inherently monitor individual tax related issues or return. Therefore, it would have been obvious to modify the process of WO 02/37345 by automatically providing the information regarding the gaming option and the contribution the IRS as taught by ZIARNO to monitor tax related information if desired. Since everything in WO 02/37345 is done on the Internet, this step can be carried out automatically along with other functions.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. NPL:

1) The article "Subscribers can take ppv on the Fly" is cited to teach well known concept of higher % contribution to the game prize increases consumer's chance in winning the sweeptakes game. "Each movie bought (or more money spent) increases a consumer's chances in the sweepstakes".

2) The article "Lure of Sweepstakes? It's human nature" is cited to teach general tips on sweepstakes of which " *It's illegal for a sweepstakes to require purchase or donations to enter and win. Buying a product doesn't increase your chances."

3) The Article "Senate ...Elderly" is cited to teach Federal low does not require consumers to buy anything to play a sweepstakes game. Still, a large number of consumers believe it will increase their chances of winning if they buy.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn

DEAN T. NGUYEN
PRIMARY EXAMINER